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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/400,034	09/21/1999	RALPH K. ITO	OLYMPUS-13	2992

7590 07/02/2003

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EXAMINER

SAVAGE, MATTHEW O

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/400,034

Applicant(s)

ITO, RALPH K.

Examiner

Matthew O Savage

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 28-63 is/are pending in the application.
- 4a) Of the above claim(s) 11-13 and 28-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 53-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-10 and 53-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Ruediger et al.

With respect to claim 1, Ruediger et al disclose a first part including a pipette tip 54 having an open tip end, a sample cup 10, 56 fluidly coupled with the pipette tip and having an open end, and a second part including a channel (e.g., defined by parts 40 44) for receiving the pipette tip of the first part, a support (e.g., defined by part 39) for accommodating at least a portion of the sample cup, and a constricted passage (e.g., defined by parts 62 and 68) arranged between the channel and support and being capable of collapsing the pipette tip as the first part is inserted into the second part in any of three modes as follows: 1) collapsing part 54 between parts 62 and 68 after it

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has been fully received within parts 39, 40, and 44 as shown in FIG. 8; 2) partially inserting part 54 into parts 39, 40, and 44, collapsing the tube between parts 62 and 68, and then fully axially inserting part 54 into parts 39, 40, and 44; partially or fully closing the gap between parts 62 and 68 with the screw operated adjustment mechanism 42 shown in FIG. 1 followed by fully axially inserting part 54 into parts 39, 40, and 44.

Concerning claims 2-3, Ruediger et al disclose the pipette as being formed of a flexible and collapsible material (see FIG. 8).

Regarding claim 4, Ruediger et al discloses an arrangement capable as functioning as recited in the claim (see modes 2 and 3 listed above).

As to claim 5, Ruediger et al disclose the length of the channel as being at least as long as a length of the pipette tip (see FIG. 13).

Concerning claim 6, Ruediger et al disclose the sample cup 56 as being dimensioned to mate with a suitable automated pipette system (e.g., one having exterior diameter equal that of the inside diameter of the cup).

Regarding claim 7, Ruediger et al disclose a support 39, 44 shaped to match a bottom of the sample cup.

Concerning claim 8, Ruediger et al disclose the support 39, 44 of the second part as being shaped to guide the pipette tip of the first part to the constricted passage as the first part is inserted into the second part.

As to claim 9, Ruediger et al disclose the support 44 as being shaped as a funnel.

Regarding claim 10, Ruediger et al disclose the support as being tapered.

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As to claim 53, Ruediger et al disclose a pipe tip that is tapered (see the tapered portion part 56).

Regarding claim 54, Ruediger et al disclose a constricted passage with a fixed cross section (e.g., after the pipette tube has been fully collapsed).

Ruediger et al discloses an apparatus capable of functioning as recited in claims 55-63 when operated in modes 2-3 listed above.

Applicant's arguments filed 4-17-03 have been fully considered but they are not persuasive.

Applicant argues that Ruediger et al fails to disclose a device capable of functioning as recited in the instant claims in view of the cited case law, however, it is held that the apparatus is capable of functioning as recited in claim 1 (see modes 1-3 listed above), and as recited in claims 4 and 55-63 (see modes 2-3 listed above) by hand without adjustment or modification of the apparatus.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

This application contains claim 11-13, and 28-52 drawn to an invention nonelected with traverse in Paper No. 6. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O Savage whose telephone number is 703-308-3854. The examiner can normally be reached on Monday-Friday, 7:00am-3:30pm.

*M. Savage*  
Matthew O Savage  
Primary Examiner  
Art Unit 1723

mos  
June 27, 2003